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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,655	10/19/2000	Gary E. Smith	GSMITH.002A	7733

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EXAMINER
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CANFIELD, ROBERT

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/692,655

Applicant(s)

SMITH, GARY E.

Examiner

Robert J Canfield

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-22, 26-31 and 37-59 is/are pending in the application.
- 4a) Of the above claim(s) 26-31 and 37 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-22 is/are allowed.
- 6) ☒ Claim(s) 38-59 is/are rejected.
- 7) ☒ Claim(s) 8 and 12 is/are objected to.
- 8) ☒ Claim(s) 8-22, 26-31 and 37-59 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03/12/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. This Office action is in response to the amendment filed 05/28/04. Claims 8-22, 26-31 and 37-59 are pending with claims 16, 17 and 37 having been withdrawn from consideration for being directed to non-elected inventions, the result of a previous restriction. Claims 16 and 17 are rejoined by the examiner. Claim 37 remains withdrawn. Claims 1-7, 23-25 and 32-36 have been canceled.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 8-22 and 38-59, drawn to roof tile support systems and methods using wedge shaped support elements.
  - II. Claims 26-31, drawn to a method of installing roof tile supports.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of Group II does not require wedge shaped support elements and as such may be practiced with other support elements.
4. Because these inventions are distinct for the reasons given above and the complete search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Lang McHardy on 10/15/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 8-22 and 38-59. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, each support element supporting four or more roof tiles in single course (claim 13) (note figures only show two tiles supported), the front end of the upper (second) tile touching the back end of the lower (first) tile (claims 22, 40, 46), the back end of the first (lower) tile touching the upper (second) tile support (claim 43), and the tall edge of a support element abutting the batten (claim 58) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The disclosure is objected to because of the following informalities: the specification states that in the embodiment of figure 3 the back end 28 of the tiles rest on the roof surface (page 5, line 26) (also note that this is not shown in this figure) and completely rests on the support element 14 (page 6, line 21, page 10 lines 13-14). It is unclear how the back end of the tiles can both rest on the roof surface 12 and completely on the support elements 14.

Appropriate correction is required.

8. Claims 8 and 12 are objected to because of the following informalities:

In claim 8 at lines 9-10 it is unclear which support element "the support element" references as a plurality have been defined; and

In claim 12, "the rear portion" lacks antecedent basis and it is unclear which tile "the tile" references.

Appropriate correction is required.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 58 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is an inadequate written description of:

the second support element being as tall as and abutting the batten. Note that the figures show the support element spaced from the batten.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claim 45 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 12 of copending Application No. 10/165601. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of the copending application teaches providing roof surface and a plurality of roof tiles supported on a wedge shaped support element and claim 11 of the copending application teaches that the tiles can be adjusted.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 38-59 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,120,132 to Kendrick.

See the embodiments of figures 2 and 8 and their descriptions.

15. Claims 8-22 are allowed.

16. The declaration under 37 CFR 1.132 filed 05/28/04 is insufficient to overcome any rejections of claims as set forth in the last Office action because: it fails to address

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any address any particular rejection and provides no factual evidence related to the claimed invention.

17. The examiner acknowledges receipt of the IDS filed 03/12/04. An initialed copy of the 1449 form is attached.

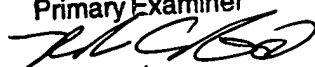
18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J Canfield whose telephone number is 703-308-2482. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Canfield  
Primary Examiner



10/17/04